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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,958	07/12/2001	Hidetoshi Onaka	15689.75	9404

7590 04/06/2007
ADRIAN J. LEE
WORKMAN, NYDEGGER & SEELEY
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Salt Lake City, UT 84111

EXAMINER

ADDY, THUAN KNOWLIN

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/903,958	Applicant(s) ONAKA ET AL.	
	Examiner Thjuan K. Addy	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/15/07 has been entered.

2. Applicant's amendment filed on March 15, 2007 has been entered. Claims 1 and 6-10 have been amended. No claims have been cancelled. No claims have been added. Claims 1-10 are still pending in this application, with claims 1, 6, 7, 8, 9, and 10 being independent.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "said first identity information" in line 21. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uusitalo (US 6,366,777), in view of Liverotti (US 6,799,057).
6. In regards to claims 1, 6, 7, and 9, Uusitalo discloses a mobile communication system (See Fig. 2-3 and GSM mobile communication system) comprising a mobile terminal (See Fig. 3 and mobile station MS) and a subscriber information management apparatus (See Fig. 3 and HLR) that manages subscriber information (See col. 4 lines 43-58), wherein said subscriber information management apparatus comprises:
detecting means for detecting a simultaneous loading of a plurality of recording media (e.g., two or more SIM cards) onto the mobile terminal, each of the plurality of recording media storing a subscriber identity to be sent to said subscriber information management apparatus so that a location area information of the subscriber identity information is registered (See col. 5-6 lines 49-6); and transmitting means for transmitting, when said detecting means detects at least two recording media, first subscriber identity information corresponding to a first recording medium along with second subscriber identity information corresponding to a newly detected recording medium so that the location area information of the second subscriber identity information is associated with the first subscriber identification information and is

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registered, to said subscriber information management apparatus (See col. 4 lines 33-58 and col. 6 lines 33-52), and wherein said subscriber information management apparatus comprises: receiving means for receiving said first subscriber identity information (i.e., first SIM card location information) along with said second subscriber identity information (i.e., second SIM card location information) from said mobile terminal; and registering means for registering location area information of said first subscriber identity information as location area information associated with said first subscriber identity information and registering the location area information of said second subscriber identity information (See col. 5 lines 33-48 and col. 6 lines 33-52). Uusitalo, however, does not disclose whereby both of said first identity information and said second subscriber identity information are activated so that simultaneous communications using said first and second subscriber identity information are allowed to said mobile terminal. Liverotti, however, does disclose whereby both of said first identity information (i.e., first of SIM cards) and said second subscriber identity information (i.e., second of SIM cards) are activated so that simultaneous communications using said first and second subscriber identity information are allowed to said mobile terminal (i.e., GSM cellular terminal, See Fig. 1) (See col. 1 lines 24-35 and col. 3 lines 9-15). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate this feature within the system, as a way of providing a cellular terminal, which is apt to allow a simultaneous use in transceiving mode of at least two service types associated with respective SIM cards, thus allowing

the cellular terminal to be able to host several SIM cards simultaneously and switch between them.

7. In regards to claim 2, Uusitalo discloses the mobile communication system, wherein said recording media is a subscriber identity module card (See Abstract and col. 4 lines 43-58).

8. In regards to claim 3, Uusitalo discloses the mobile communication system, wherein said first subscriber identity information is subscriber identity information stored in said first recording medium or temporary subscriber identity information corresponding to the subscriber identity information stored in said first recording medium, and said second subscriber identity information is subscriber identity information stored in said newly detected (e.g., active) recording medium (See Abstract and col. 6 lines 33-52).

9. In regards to claim 4, Uusitalo discloses the mobile communication system, wherein said first subscriber identity information and said second subscriber identity information are associated with respective telephone numbers (e.g., MSISDN number) (See col. 6 lines 54-58).

10. In regards to claim 5, Uusitalo discloses the mobile communication system, wherein said first subscriber identity information and said second subscriber identity information are associated with mail addresses (e.g., locations) (See col. 4 lines 43-58).

11. In regards to claims 8 and 10, Uusitalo discloses a mobile network system (See Fig. 2-3 and GSM mobile communication system) comprising: managing means for managing communication state of a mobile terminal having at least two telephone

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numbers or mail addresses, wherein said mobile terminal is simultaneously loadable with a plurality of recording media, said each of the plurality of recording media storing a subscriber identity of which location area information is registered, each of said at least two telephone numbers or mail addresses being associated with any of said subscriber identity information, said mobile telephone being able to communicate with any of said at least two telephone numbers or mail addresses when the location area information of the subscriber identifies are registered (See col. 5 lines 33-48 and col. 6 lines 54-58); judging means for judging, when an incoming call to said mobile terminal occurs, whether said mobile terminal is in communication by using any one of said telephone numbers, based on said communication state; and processing means for performing a process for said incoming call in accordance with said judgment (See Abstract and col. 6-7 lines 63-5). Uusitalo, however, does not disclose said mobile terminal being able to establish simultaneous communications with any of said at least two telephone numbers or mail addresses when the location area information of the subscriber identifies are registered and activated. Liverotti, however, does disclose said mobile terminal (i.e., GSM cellular terminal, See Fig. 1) being able to establish simultaneous communications with any of said at least two telephone numbers or mail addresses when the location area information of the subscriber identifies are registered and activated (See col. 1 lines 24-35 and col. 3 lines 9-15).

Response to Arguments

12. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miyashita (US 6,244,894) teaches a cellular phone battery equipped with IC card.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan K. Addy whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, reading "Thjuan K. Addy". The signature is fluid and cursive, with a long horizontal flourish extending from the bottom of the name.

Thjuan K. Addy
Patent Examiner
AU 2614